

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner took the following actions:

- (i) rejected claims 1, 23, and 45 under 35 U.S.C. § 112, second paragraph;
- (ii) rejected claims 1-8, 10, 12, 13, 17-30, 35, 39-45, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,839,737 to Friskel et al. ("*Friskel*") in view of U.S. Patent Application Publication No. 2004/0054733 to Weeks et al. ("*Weeks*");
- (iii) rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view of *Weeks* and further in view of U.S. Patent Application Publication No. 2005/0086305 to Koch et al. ("*Koch*"); and
- (iv) rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel*, in view of *Weeks* and further in view of U.S. Patent Application Publication No. 2003/0212745 to Caughey et al. ("*Caughey*").

Applicants amend claims 1, 13, 23, 35, and 45, and add new claims 50-55. No impermissible new matter has been added. Of these, claims 1, 23, 45, 50, and 53 are independent.

**I. Rejection under 35 U.S.C. § 112, second paragraph**

Applicants respectfully traverse the rejection of the claims under 35 U.S.C. § 112, second paragraph. The Office Action, on page 2, makes a general assertion that

the limitation determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person is vague and indefinite, wherein the

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<sup>1</sup> The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

examiner interprets the limitation as if the receiver of an email prints, moves, or opens the message for a predetermined time then the sender of the email is known and added to the buddy list.

Applicants respectfully submit that one of ordinary skill in the art can ascertain the meets and bounds of the claimed invention. Additionally, "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the [E]xaminer might desire." MPEP § 2173.02. "Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement." *Id.*

Accordingly, for at least the above reasons, Applicants request that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

**II. Rejection under 35 U.S.C. § 103 based on *Friskel* and *Weeks***

Applicants respectfully traverse the rejection of claims 1-8, 10, 12, 13, 17-30, 35, 39-45, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view *Weeks*. The Office Action fails to establish a *prima facie* case of obviousness, at least because there are significant differences between the cited art and the claimed invention, and the rejection fails to consider the claimed invention as a whole.

For example, independent claim 1 recites a combination of elements including, among other things,

determining, at the one or more computers, that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person, the actions including one or more of (1) saving the one or more messages from

the person; (2) printing the one or more messages from the person; (3) moving the one or more messages from the person from an inbox to a folder; and (4) leaving the one or more messages from the person open for a predetermined period of time.

The cited art, alone or in combination, fails to disclose or suggest at least the aforementioned features of claim 1.

The Office Action, on page 5, concedes that

Friskel et al. fails to teach determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person, the actions including one or more of (1) saving a message from the person; (2) printing a message from the person; (3) moving a message from the person from a first folder to a second folder; and (4) leaving a message from the person open for a predetermined period of time.

Instead, the Office Action relies upon *Weeks*.

*Weeks*, however, fails to cure the deficiencies of *Friskel*. The Office Action asserts, on page 5, that “Weeks et al. teaches the user removes an e-mail from the e-mail stop folder 104 . . . in order to add the user’s address to the sender’s address, . . . Weeks et al. further teaches that in response to determining that the person is known to the user, adding the person to the maintained list.” Even if this assertion is correct, which Applicants do not concede, *Weeks* still fails to disclose or suggest all of the features of Applicants’ claims, including “determining that a person is known to the user based, at least in part, on . . . moving the one or more messages from the person from an inbox to a folder,” as recited in independent claim 1. As such, for at least these reasons, independent claim 1 is patentable over the asserted prior art.

The Examiner relies upon *Friskel* to disclose the amended "inbox" features of claim 1, previously recited in dependent claim 13. However, the Examiner's assertion in this regard contradicts the Examiner's prior concession that *Friskel* "fails to teach determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person, the actions including one or more of . . . moving a message from the person from a first folder to a second folder." Office Action at p. 5. Accordingly, for this reason, the rejection fails to consider the claimed invention as a whole and a *prima facie* case of obviousness has not been established.

Further, while *Friskel* permits "an end user of the application to determine in . . . an 'in-box,' the on-line status of those persons . . . who have sent e-mail messages . . . to the user" (*Friskel*, col. 2, lines 51-56), *Friskel* still fails to disclose or suggest all of the features of Applicants' claims, such as "determining . . . that a person is known to the user based, at least in part, on . . . moving a message from the person from an inbox to a folder," as recited in independent claim 1. There is no disclosure or teaching of this feature by the system of *Friskel*, and the Office Action fails to establish this otherwise.

In view of the foregoing, there are significant differences between the cited art and independent claim 1 that the Office Action fails to address. Accordingly, the Office Action fails to establish a *prima facie* case of obviousness with respect to claim 1, and the rejection for claim 1 should be withdrawn.

Independent claims 23 and 45, while different in scope, distinguish over the cited art for at least similar reasons to that presented above for claim 1. Claims 7-10, 12, 12, 13, 17-22, 24-30, 35, 39-44, 47, and 49 depend from one of the allowable independent

claims 1 and 23 and, therefore, distinguish over the prior art of record in view of claims 1 and 23, and further in view of the additional features recited in each of these claims.

Accordingly, the rejections based on *Friskel* and *Weeks* should be withdrawn and the pending claims allowed.

**III. Rejection under 35 U.S.C. § 103(a) based on *Friskel*, *Weeks*, and *Koch***

Applicants respectfully traverse the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view *Weeks* in further view of *Koch*. The Office Action fails to present a *prima facie* case of obviousness. Claim 11 depends from amended claim 1 and, therefore, should be allowed.

As discussed above, combinations of *Friskel* and *Weeks* fail to disclose each and every feature of claim 1. Similarly, *Koch* also fails to disclose or even suggest the aforementioned features of claim 1, nor does the Examiner rely upon *Koch* to do so.

Accordingly, there are significant differences between the cited art and Applicants' claims that the Office Action fails to address. As such, a *prima facie* case of obviousness has not been established with respect to claim 1 or dependent claim 11, and the claims should be allowed.

**IV. Rejection under 35 U.S.C. § 103(a) based on *Friskel*, *Weeks*, and *Caughey***

Applicants respectfully traverse the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view *Weeks* in further view of *Caughey*. The Office Action fails to present a *prima facie* case of obviousness. Claim 14 depends from claim 1 and, therefore, should be allowed.

As discussed above, combinations of *Friskel* and *Weeks* fail to disclose each and every feature of amended claim 1. Similarly, *Chaghey* also fails to disclose or even

suggest the aforementioned features of claim 1, nor does the Examiner rely upon *Chaughey* to do so.

Accordingly, there are significant differences between the cited art and Applicants' claims that the Office Action fails to address. As such, a *prima facie* case of obviousness has not been established with respect to claim 1 or dependent claim 14, and the claims should be allowed.

**V. New claims 50-55**

New claims 50-55 are submitted by this Amendment and recite features that are neither disclosed nor suggested by *Friskel* and *Weeks*, or the other references of record. Accordingly, Applicants respectfully request consideration and allowance of these claims by the Examiner.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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